

Remarks

Claims 1 to 3, 5 to 13 and 15 to 17 are pending in the application. Claims 1, 7, 8, 9, 10, 11 and 15 have been amended herewith. Claims 4 and 14 have been cancelled. Claims 16 and 17 are submitted by way of the present amendment. No new matter has been added.

Regarding the rejection of claim 14 under 35 U.S.C. § 112, it is submitted that the cancellation of claim 14 renders this rejection moot.

Regarding the rejection of claims 1 to 3 and 5 to 8 as allegedly being anticipated by Stockl *et al.* (US 4,883,714), reconsideration by the examiner is respectfully requested based on the amendment of claim 1, specifying that “*said binder is a biodegradable amphiphilic compound*”. The support for this amendment can be found in claim 4. Since Stockl *et al.* does not disclose an amphiphilic compound as a binder, it is requested that the rejection of claims 1 to 3 and 5 to 8 under 35 U.S.C. § 102(b) be removed. As a result of this amendment, claim 4 has been cancelled.

For purposes of consistency, claim 15 has also been amended so as to specify that the binder is a *biodegradable amphiphilic compound*.

Regarding the rejection of claims 1 to 15 as allegedly being obvious over Carumpalos *et al.* (US 4,163,001), reconsideration by the examiner is respectfully requested based on the following grounds: Carumpalos *et al.* describe an ink concentrate comprising multiple elements. Amongst those elements, the examiner has equated the non-ionic surfactants (i.e. polyvinylalcohol and polyvinylpyrrolidone) as corresponding to the biodegradable polymer of the present invention. However, the surfactants disclosed by Carumpalos are hydrophilic whereas the polymer used in the present invention is *hydrophobic* (as now claimed in claim 1, support for this amendment being inherent throughout the disclosure but more particularly on page 5, lines 14-25 of the application as filed). The claimed hydrophobic polymers of the present invention can not constitute a homogenous ink solution unless there is an amphiphilic compound acting as a binder as is claimed in the present application. Carumpalos *et al.* provides no suggestion or motivation for a person skilled in the art to replace the hydrophilic non-ionic surfactants for the hydrophobic biodegradable polymers of the instant invention and certainly does not give any indication that an amphiphilic compound would be added to attain a homogenous ink solution.

For this reason, it is submitted that claims 1 to 15 are not obvious in light of Carumpalos *et al.*, and withdrawal of the rejection under § 103 is respectfully requested.

Support for the amendment brought to claim 7 can be found in the application as filed on page 14, line 19.

Support for newly submitted claims 16 and 17 can be found in the application as filed on page 14, lines 19 and 20.

Dependency of claims 8, 9, 10 and 11 has been adjusted for consistency.

The applicant submits that no new matter has been introduced by way of the present amendment.

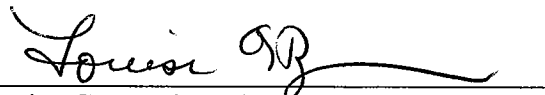
The applicant also wishes to inform the examiner that the corresponding European patent application has matured into European patent EP 1,470,199B1 (enclosed herewith).

It is therefore submitted that the claims are in condition for allowance. Reconsideration of the examiner's rejection is respectfully requested. Allowance of claims 1 to 5, 5 to 13 and 15 to 17 at an early date is solicited.

In the event that there are any questions concerning this amendment or the application in general, the examiner is respectfully urged to telephone the undersigned so that prosecution of the application may be expedited.

A fee of 60\$ for a one-month extension for small entity is required by this response. Authorization is hereby given to charge account number 19-5113 with this amount. No additional fees are believed to be necessitated by the present response. However, should this be an error, authorization is hereby given to charge deposit account 19-5113 for any underpayment or to credit any overpayment.

Respectfully,

A handwritten signature in dark ink, appearing to read "Louise G. Bernier", is written over a horizontal line.

Louise G. Bernier, Ph.D.

Reg. No. 38,791

Agent for the Applicant

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